Supreme Court, U.S.
FILED
NOV 9
JOSEPH F. SPANIOL, JR.
CLERK

No. 90-572

IN THE

Supreme Court of the United States

OCTOBER TERM, 1990

WILSON SPORTING GOODS CO.,

Petitioner,

v.

DAVID GEOFFREY & ASSOCIATES d/b/a SLAZENGER,
and
DUNLOP SLAZENGER CORPORATION
aka DUNLOP SPORTS CORPORATION,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITIONER'S REPLY BRIEF IN SUPPORT OF THE PETITION

John W. Chestnut
Counsel of Record
Tilton, Fallon, Lungmus & Chestnut
100 South Wacker Drive, Suite 960
Chicago, Illinois 60606-4002
(312) 263-1841

Charles B. Brown
Wilson Sporting Goods Co.
2233 West Street
River Grove, Illinois 60171
(708) 456-6100

Counsel for Petitioner

TABLE OF CONTENTS

	PAGE
INTRODUCTION	1
THE FEDERAL CIRCUIT IS SUBJECT TO THIS COURT'S REVIEW	2
THE JURY'S CONSIDERATION OF PRIOR ART IS NOT SUBJECT TO DE NOVO REVIEW BY THE FEDERAL CIRCUIT	3
EVEN IF THE FEDERAL CIRCUIT'S HYPOTHETICAL CLAIM ANALYSIS IS ACCEPTED, THE ISSUE OF PATENTABILITY NECESSARILY INCLUDES QUESTIONS OF FACT	4
CONCLUSION	5

TABLE OF AUTHORITIES

Cases:

Graham v. John Deere Co., 383 U.S. 1 (1966)	4,5
Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605 (1950)	1, 2, 3, 4
Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861 (Fed. Cir. 1985)	3

Statutes, Regulations, and Rules:

28 U.S.C. §1254(1)	2

No. 90-572

IN THE

Supreme Court of the United States

OCTOBER TERM, 1990

WILSON SPORTING GOODS CO.,

Petitioner,

v.

DAVID GEOFFREY & ASSOCIATES d/b/a SLAZENGER,
and
DUNLOP SLAZENGER CORPORATION
aka DUNLOP SPORTS CORPORATION,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITIONER'S REPLY BRIEF IN SUPPORT OF THE PETITION

INTRODUCTION

Wilson has petitioned for a writ of certiorari to review the judgment of the Federal Circuit that Wilson's patent on a golf ball dimple pattern is not infringed by Dunlop and DGA (collectively "Dunlop"). Wilson asserts that the Federal Circuit's hypothetical claim analysis and *de novo* determination of the prior art as matters of law conflict with this Court's holding in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950), and deprived Wilson of a jury trial on issues of fact.

THE FEDERAL CIRCUIT IS SUBJECT TO THIS COURT'S REVIEW

Dunlop's opening argument is surprising and frightening:

> The three judges on the Federal Circuit panel are so experienced and so knowledgeable on patent matters that they could not possibly have overruled or eroded *Graver* (Opposition, p. 1-2).

The federal judicial system has always been based on the principle that decisions of inferior courts are subject to review by the Supreme Court. If a litigant argues that the judges of an inferior court, because of some special legal or technical expertise, are insulated from this Court's review, then that is the first step toward judicial anarchy.

When Congress established the Federal Circuit, it made the Federal Circuit subject to review under 28 U.S.C. §1254(1) just like any other circuit. This Court's decisions in patent matters are still the law of the land and must be followed by the Federal Circuit.

Dunlop even argues that Wilson has failed to acknowledge that a writ of certiorari requires "special and important reasons" for this Court's review (Opposition, p. 8). In a patent case there is probably no more special or important reason for review than the fact that the decision of the inferior court conflicts with this Court's precedent.

Judges, even patent judges, make mistakes. A mistake has been made in this case which affects basic propositions of patent law, and this Court should correct it.

THE JURY'S CONSIDERATION OF PRIOR ART IS NOT SUBJECT TO DE NOVO REVIEW BY THE FEDERAL CIRCUIT

This Court in *Graver* clearly stated that equivalence is a factual determination, that evidence of prior art is considered in determining equivalency, and that appellate courts, even this Court, should not "essay an independent evaluation of this evidence. That is the function of the trial court." 339 U.S. at 609-611.

Since the Federal Circuit did not disagree with the jury's factual findings, the jury verdict on equivalence should have been affirmed. However, the Federal Circuit reversed by treating certain matters as questions of law which could be reviewed *de novo.*

Dunlop argues that the Federal Circuit's *de novo* review as a question of law is "firmly supported by precedent" (Opposition, p. 10). However, the only case cited by both Dunlop and the Federal Circuit for that proposition is the 1985 decision of the Federal Circuit in *Loctite Corp.* v. *Ultraseal Ltd.*, 781 F.2d 861, 870 (Fed. Cir. 1985). The Federal Circuit cannot bootstrap itself into ignoring Supreme Court precedent by relying on its own cases.

Dunlop also erroneously asserts that the Federal Circuit decision is not contrary to *Graver* because the issue of equivalency in view of the prior art was "not even before the Court in *Graver Tank*" (Opposition, p. 7-8). The majority in *Graver* specifically stated that what constitutes equivalency must be determined against the prior art. 339 U.S. at 609. The majority rejected the dissenting view that the Court was using the doctrine of equivalents "to extend a patent to a composition which could not be patented." 339 U.S. at 618. The issue was thus squarely before this Court in *Graver*, and the Federal Circuit's hypothetical claim analysis adopts the dissent rather than the majority.

By engaging in *de novo* review of the prior art, the Federal Circuit erroneously concluded that the prior art Uniroyal ball had a *total* of only 30 dimples which intersected the six great circles (App. 7a, 16a). That erroneous conclusion was the linchpin of the court's reversal of the jury verdict of infringement. The only testimony on the Uniroyal ball unequivocally stated that there were 30 intersecting dimples on *each* great circle (Petition, p. 12). Dunlop responds by stating that the Federal Circuit could not have committed factual error because Wilson's petition for rehearing was denied. However, the three judges who denied the petition for rehearing were the same judges who made the initial error.

Dunlop even improperly bolsters its arguments regarding the prior art by referring to a photograph and a drawing of a Royal Master ball (Opposition, p. 3 n. 3). Neither the photograph nor the drawing was admitted into evidence by the district court.

EVEN IF THE FEDERAL CIRCUIT'S HYPOTHETICAL CLAIM ANALYSIS IS ACCEPTED, THE ISSUE OF PATENTABILITY NECESSARILY INCLUDES QUESTIONS OF FACT

As Wilson stated on page 13 of the Petition, the consideration of obviousness necessarily requires the determination of the factual issues set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18 (1966). Those factual issues include the scope and content of the prior art, the differences between the prior art and the claims, and the level of ordinary skill. The Federal Circuit's *de novo* determination of the patentability of a hypothetical claim, which the Federal Circuit itself drafted, contradicted *Graham* and improperly deprived Wilson of the jury decision in its favor.

Dunlop offers the surprising rebuttal that *Graham* is not applicable because it was concerned only with the validity of a *literal* claim and not a *hypothetical* claim (Opposition,

p. 11). Even the Federal Circuit did not state that the test for patentability of a hypothetical claim is somehow different than the test for a real claim. *Graham* held that the issue of patentability involves factual determinations, and that mandate must be followed even for hypothetical claims.

CONCLUSION

This Court should reject the suggestion that its supervisory power should not be exercised in patent cases and should grant the Petition for Writ of Certiorari to the Federal Circuit.

Respectfully submitted,

John W. Chestnut
Counsel of Record
Tilton, Fallon, Lungmus & Chestnut
100 South Wacker Drive, Suite 960
Chicago, Illinois 60606-4002
(312) 263-1841

Charles B. Brown
Wilson Sporting Goods Co.
2233 West Street
River Grove, Illinois 60171
(708) 456-6100

Counsel for Petitioner

November 8, 1990